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displaying to a prospective purchaser registrant gift data, that identifies at least one of said potential gifts for a particular registrant and the particular merchant associated with said at least one of said potential gifts, in response to an inquiry from said prospective purchaser.

REMARKS

In an Office Action dated 20 February 2002, the Examiner objected to the Reissue Oath/Declaration, noted the necessity of surrendering the original patent, requested the submission of papers missing from the file. The Examiner further rejected claims 1-29 under 35 U.S.C. 251 as being improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based. The Examiner also noted that claims 1-29 are allowable over the prior art. Applicant has amended independent claims 1, 15, 20, 25.

The Examiner objected to the Reissue Oath/Declaration and Applicant shall submit an amended Reissue Oath/Declaration in a separate filing.

The Examiner noted the necessity of surrendering the original patent before the Notice of Allowance is issued pursuant to 37 CFR 1.178. Applicant shall address this issue in a separate filing.

The Examiner requested copies of the IDS non-patent literature and the Assent of Assignee under 3.73(b), which are missing from the file. Applicant has enclosed these documents. If additional documents appear to be missing from the USPTO file, Applicant will immediately forward replacement copies.

The Examiner further rejected claims 1-29 under 35 U.S.C. 251 as being improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based. The Examiner noted with respect thereto:

A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the

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claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for patent cannot be recaptured by the filing of the present reissue application.

Applicant's broadening of the claims has been considered in light of the prosecution of the parent case and it seems to be improper recapture. Applicant's arguments of 12 September 1997, repeated in the Preliminary Amendment, argue that the registry serves a plurality of stores in a shopping area, not stores which are in spatially distant areas. Applicant's amendment of 30 June 2000 removes the proximity limitation from both the stores and the registry, which is seen as improper recapture.

Applicant appreciates the Examiner's thorough review of the reissue application and the prosecution history of the original application for patent. Applicant has amended independent claims 1, 15, 20, 25 in order to traverse the Examiner's rejection of claims 1-29 under 35 U.S.C. 251. In particular, in the Office Action dated 20 June 1997 in the original application for patent, the Examiner noted:

Thus plural stores have access to the same registry database. In essence each store can be considered a different merchant, and indeed literally so when one uses the known definition of "merchant" of being a different shopkeeper and store site. This can also be considered true especially when a chain consists of plural franchise owners and their stores.

In response to this rejection, in the Amendment of 12 September 1997, Applicant argues:

The claims as amended are drawn to a gift registry that serves a plurality of merchants each having a store in a shopping area. Neither Applicants' admitted prior art nor the publication article is drawn to a registry serving a plurality of merchants, each merchant having a store in a shopping area. In fact, the publication article inferentially teaches away from the registry serving a number of stores in a shopping area. The registry in the publication article serves a number of stores under common ownership in a chain of stores. Typically the individual stores making up the chain of stores are located distant from one another in order to attract customers from a number of spatially distant areas, as distinct from the present invention in which the registry serves a number of different stores in a shopping area.

In view of this record, Applicant has amended the independent claims to remain

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consistent with the above-noted discussion and has reinserted the store proximity limitation into these claims. Applicant believed that claims 1-29 are now allowable under 35 U.S.C. 251.

Applicant therefore respectfully requests that the Examiner reconsider the present rejection of Applicant's claims and that a Notice of Allowance be issued in a timely manner. If the Examiner believes that any further issues need to be addressed, or has proposed clarifications to the claims, the undersigned is available at the convenience of the Examiner for a telephone interview to address these issues.

It is believed that no fees are due at this time; however, Applicants authorize the Commissioner to charge any additionally required fees to deposit account #50-1848.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

1. (Amended) A multi-merchant gift registry system for enabling a registrant to input gift information into a gift registry that is maintained for the stores of a plurality of merchants that are located in an area, the gift registry system comprising:
at least one data terminal comprising:

a first data entry system through which first information and inquiries about registrants in the gift registry are entered into the gift registry system, the first information for each registrant including at least the registrant's name;

a second data entry system capable of receiving second information, the second information including a list of potential gifts which the registrant has identified and a unique identifier associated with the particular merchant having each of the desired gifts;

a database storage system that stores and retrieves the first and second information about the registrant and the unique identifier associated with the particular merchant having each of the desired gifts; and

a display system that displays the list of potential gifts for a particular registrant and information about the particular merchants the desired gifts are from, including the unique identifier associated with the particular merchant having each of the desired gifts, in response to an inquiry from a prospective purchaser.

15. (Amended) A multi-merchant gift registry system for registering items, that are selected by a registrant from items available from a plurality of merchants that are located in an area, as possible gifts for the registrant, the multi-merchant gift registry system comprising:

first data entry means through which first information, including at least a registrant name, are entered into said gift registry system;

second data entry means capable of receiving second information, including data identifying potential gifts which said registrant has selected and a unique merchant identifier associated with each of said potential gifts;

database storage means for storing and retrieving said first information and said second information; and

display means for displaying registrant gift data, that identifies at least one of said potential gifts for a particular registrant and the particular merchant associated with said at least one of said potential gifts, in response to an inquiry from a prospective purchaser.

20. (Amended) A multi-merchant gift registry system for registering items, that are selected by a registrant from items available from a plurality of merchants that are located in an area, as possible gifts for the registrant, the multi-merchant gift registry system comprising:

at least one registrant terminal device comprising:

first data entry means through which first information, including at least a registrant name, are entered into said gift registry system,

second data entry means capable of receiving second information, including data identifying potential gifts which said registrant has selected and a unique merchant identifier associated with each of said potential gifts;

server means in communication with said at least one registrant terminal device, comprising:

database storage means for storing and retrieving said first information and said second information, and

display means for displaying registrant gift data, that identifies at least one of said potential gifts for a particular registrant and the particular merchant associated with said at least one of said potential gifts, in response to an inquiry from a prospective purchaser.

25. (Amended) A method of operating a multi-merchant gift registry system for registering items, that are selected by a registrant from items available from a plurality of merchants that are located in an area, as possible gifts for the registrant, the

multi-merchant gift registry system comprising at least one registrant terminal device for enabling a registrant to enter registrant gift data into said gift registry system and a server to receive and store said registrant gift data, said method of operating a multi-merchant gift registry system, comprising the steps of:

entering first data, including at least a registrant name, into said gift registry system via said registrant terminal device;

entering second data, including data identifying potential gifts which said registrant has selected and a unique merchant identifier associated with each of said potential gifts, into said gift registry system via said registrant terminal device;

storing and retrieving said first information and said second information in a database; and

displaying to a prospective purchaser registrant gift data, that identifies at least one of said potential gifts for a particular registrant and the particular merchant associated with said at least one of said potential gifts, in response to an inquiry from said prospective purchaser.